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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,850	02/26/2007	Jae-Yeol Park	7120P001	2288
7590 03/17/2011 Blakely, Sokoloff, Taylor & Zafman 12400 Wilshire Boulevard 7th Floor Los Angeles, CA 90025				
EXAMINER				
SHEEHAN, JOHN P				
ART UNIT		PAPER NUMBER		
1736				
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03/17/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/576,850

## Applicant(s)

PARK ET AL.

## Examiner

John P. Sheehan

## Art Unit

1736

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-7 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 18, 2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 5 to 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Moro et al. (Moro '841, US Patent No. 5,651,841, cited by the Examiner) and Bae (Bae '399, US Patent No. 5,470,399, cited by the Examiner).as applied to claims 1 and 2 above, and further in view of Japanese Patent Document No. 4-165607 (Japan '607, cited in the IDS submitted October 9, 2009).

Moro '841 teaches a specific example that employs a MPP alloy powder having a composition that is encompassed by the MPP composition recited in applicants' claims

that is made by atomization, a spray process, as recited in applicants' claims (column 10, lines 54 to 56). Moro '841 teaches specific examples of powder particle sizes in the range of 8 to 85  $\mu\text{m}$  (column 10, lines 39 and 56). Moro '841 teaches that each of the powders is mixed with a resin, a titanate and a lubricant which are encompassed by the insulation coating recited in applicant' claims (column 10, line 53 to column 11, line 4). The coated powders are compacted at a pressure of 10 tons/cm<sup>2</sup> and the compacted powders are then heat treated at 700°C (column 11, lines 7 to 9). This compaction pressure and heat treatment temperature are encompassed by the compaction pressure and heat treatment temperature recited in each of applicants' claims. Thus, Moro '841 teaches a soft magnetic product that, with the exception of the unit block dimensions, is encompassed by the instant claims and which is made by a process that is similar to the process recited in applicants' claims.

Bae '399 teaches a MPP powder having a composition that overlaps the MPP composition recited in applicants' claims that is made by spouting a fluid into the flow of the Ni-Fe-Mo melt, a spray process, as recited in the applicants' claims (column 3, lines 22 to 26). The MPP powder is then coated with a ceramic which is encompassed by the insulation coating recited in applicant' claims, molding the coated particles and annealing the compacted particles (column 3, lines 27 to 35). Bae '399 teaches that the coated powder is compacted at a pressure of 240,000 psi (18.6 tons/cm<sup>2</sup>) (column 7, line 38) and then heat treated at 670°C which is encompassed by the heat treatment temperature recited in applicants' claims. Thus, Bae '399 teaches a soft magnetic product that, with the exception of the unit block dimensions, is encompassed by the

instant claims and which is made by a process that is very similar to the process recited in applicants' claims.

Japan '607 teaches that it is known in the core art to combine individual cores using epoxy to form a larger core.

The claims and each of Moro '841 and Bae '399 differ in that Moro '841 and Bae '399 do not teach the unit block dimensions, unit block shape and the exact process conditions as recited in applicants' claims and are silent with respect to combining the individual cores.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the unit block dimensions and shapes recited in the instant claims would have been obvious to one of ordinary skill in the art at the time the invention was made because the dimensions and shape of the unit blocks are considered to be merely a matter of size and shape of the unit blocks. The size and shape of a product does not lend patentability to the claimed product, MPEP 2144.04 (IV)(A).

#### **IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS**

##### **A. Changes in Size/Proportion**

In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding combining of unit blocks, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Japan '607 teaches that it is a well known practice in the art to join individual cores.

Regarding the process conditions recited in the instant claims, the Examiner notes that the claims are directed to a product and not a process. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

### ***Response to Arguments***

4. Applicant's arguments filed October 16, 2010 have been fully considered but they are not persuasive.
5. Applicants argue that Moro '841, Bae '399 and Japan '607 all fail to teach forming the unit blocks at a pressure of 10 tons/cm<sup>2</sup>-18 ton/cm<sup>2</sup> and heat treating the compacted unit block at 600°C-800°C for 1 to 2 hours in an inert atmosphere and a unit

block having a length of 3-10 cm, a width of 1-5cm and a height of 1-5 cm. This is not persuasive. The claims are directed to a product and not a process. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113. Applicants have not shown that the differences between the process steps recited in applicants' product by process claims and the processes taught by each of Moro '841 and Bae '399 actually, in fact, results in a different product. Regarding the claimed unit block dimensions and shape, as set forth in the statement of the rejection, the dimensions and shape of the unit blocks are considered to be merely a matter of size and shape of the unit blocks. The size and shape of a product does not lend patentability to the claimed product, MPEP 2144.04 (IV)(A).

#### **IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS**

##### **A. Changes in Size/Proportion**

In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit

held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/John P. Sheehan/  
Primary Examiner  
Art Unit 1736

JPS